

REMARKS

Claims 12-21, 43-46, 49 and 68 are rejected under 35 U.S.C. §101. In Claim 12, the Examiner finds that it is not clear regarding what is meant by "address information." Applicants respectfully disagree because Claim 12 identifies an "another party to the transaction" in the paragraph that begins "receives, from each of the plurality of merchant computers,...." The claim also recites that the control system "validates (formerly validating) or invalidates (formerly invalidating) address information associated with the another party...." Consequently, the address information refers to the address information associated with the another party to the transaction. As is also clear from the claim, the "another party" is the merchant's customer, for example, and certainly not the merchant. Regardless, the amendments made to Claim 12 include incorporating the same language so that it is clear that the address information is associated with the another party to the transaction. No longer is there any "option" available as to what address information refers to because it refers to the "another party to the transaction."

Claims 12-21, 43-46, 47, 49 and 68 were rejected under Section 112, second paragraph, as being indefinite. First, the Examiner finds that Claim 12 is unclear because it recites the control system is associated with "providing business rules of the first merchant." Because the control system provides all business rules from which the first merchant selects its business rules, ;the control system does provide business rules of the first merchant. Regardless, this objected-to claim language has been deleted and replaced by claim language reciting "said control system... validates or invalidates using business rules of the first merchant...."

Claim 12 is also rejected under Section 112 based on the same reasoning employed in making the rejection under Section 101. For the same reasons given in the discussion of Section 101, Claim 12 should no longer be rejected under Section 112.

Claim 47 is found to be unclear because it uses the claim language "obtained from at least the following business rules." Applicants submit that this could mean one or both of chosen from among the rules or derived as a combination of the rules. In any event, Claim 47 has been amended to recite that the business rules are "selected" in order to obviate this ground for rejection.

Claim 47 is also allegedly unclear because "tax to collect and being obtained" and "shipping and being obtained" are included. For the same reasoning just provided, Applicants respectfully

disagree. In any event, the term "obtained" has been deleted and the term "selected" has been substituted therefor in each of these two instances.

Claims 12-21, 43-46, 49 and 68 are objected to because Claim 12 (p. 3, l. 45) includes the term "process." This claim term has been deleted and replaced with the term "processing," as noted by the Examiner. Claim 12 (p. 3, l. 47) also includes the claim expression "is there." This has been deleted and replaced with "determining if there is," as suggested by the Examiner. Hence, the informalities have been overcome.

Regarding the substantive rejections of the claims, Claims 12-17, 20, 21, 43, 45, 46, 49 and 68 have been rejected under Section 103(a) as being unpatentable over the patent to Golden et al. (US 5,774,872) in view of the publication entitled "System Overview for Internet Transaction Servers" (hereinafter identified as "Taxware") and the publication Gralla entitled "How the Internet Works" (hereinafter referred to as "Gralla").

On pages 4 and 5 of the Office Action, the Examiner asserts that the basis for obviousness is predicated on a combination of number of prior art references. However, no prior art reference is relied on, and no prior art reference can be relied on, for the combination of patentable limitations found at the end of Claim 12. Instead, the Examiner asserts that "this appears only to be an intended use of the apparatus and not a further limitation of the apparatus." Applicant respectfully disagrees, particularly in light of the amended and emphasizing claim language which requires that the control system perform the "validates or invalidates" functions recited therein. As implicitly found by the Examiner, the prior art does not teach or suggest a control system that performs such functions.

Since these features of the control system have already been considered during examination, and the amendments emphasize that these patentable features are claim limitations and not an intended use of the apparatus, entry of the amendments to Claim 12 in order to place this claim in condition for allowance is appropriate.

Dependent Claims 13-21, 43-46 and 68 are patentable, at least for the same reasons as Claim 12.

Referring to independent Claim 47, on pages 7 and 8 of the Office Action, the Examiner contends that the combination of prior art references renders the invention obvious. Among other things, it is stated: "It also shows that the control system uses first business rules and nexus

information, wherein the first business rules are related to a tax method, which taxes to collect and how to treat shipping expenses. It is inherent that these business rules are used since the questions addressed in them must be answered to correctly calculate taxes." Applicants respectfully disagree. Nowhere does Golden teach or suggest business rules selected by the merchant from a number of business rules. Instead, at best, Golden teaches one tax method calculation, one way to collect taxes and one way to treat shipping expenses. Such is not tantamount to a merchant selecting from a number of business rules. Moreover, Claim 47 specifically and patentably distinguishes Golden by identifying the business rules from which the first merchant makes the selection. These business rules are identified as (1)(a)-(d), (2)(a)-(e) and (3)(a)-(d) of Claim 47. Like Claim 12, the Examiner recognizes that none of the prior art references disclose these business rules for selection. Applicants respectfully and specifically request that it be pointed out where in the disclosure of Golden a merchant selects from the business rules, particularly those defined in Claim 47. Again, when all patentable limitations of Claim 47 are compared with the prior art references, the rejection cannot be supported and should be withdrawn.

Claim 48 is rejected under Section 103(a) as being unpatentable over the Golden et al. patent in view of the Taxware publication and further in view of the patent to Chong (US 5,335,169).

The Chong patent discloses a computerized system for making determinations related to taxes. A support file identifies different tax types, taxing authorities, tax rates, customers and sales types. Customers that use this system enter customer data that is used by the system for making the tax determinations. The customer data includes customer identification numbers, customer names, customer addresses, customer location code, the tax rate code and the tax type code. This data is accessed and used by the tax determining software for performing desired calculations. This is data to be entered, not the defined business rules. The first set of business rules and the second set of business rules of Claim 48 are selected by the first merchant and the second merchant, respectively. These are used in determining how the system calculates taxes. The first set of business rules selected by the first merchant includes perform tax calculations for the tax authority selected by the first merchant as specified in a request with sale transaction data from the first merchant, collect taxes for those tax authorities in which there is an agreement between the control system and the tax authorities for accepting taxes on behalf of the merchant via ACH, and shipping costs are itemized

A sincere effort has been made to place the application in condition for allowance and avoid the necessity of appeal. Even if the Examiner finds that the claims are not patentable over the prior art, the amendments to the claim should be entered in order to place them in better form for appeal.

Respectfully submitted,

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Date: February 6, 2009



Creation date: 07-27-2005
Indexing Officer: LCHEO - LEE CHEO
Team: OIPEBackFileIndexing
Dossier: 09710443

Legal Date: 03-05-2004

No.	Docode	Number of pages
1	CTAV	3

Total number of pages: 3

Remarks:

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